

DFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Robert N. Goman et al.

Title: SMART CARD PERSONALIZATION IN A MULTISTATION ENVIRONMENT

Docket No.: 457.010US3

Filed: October 23, 2003

Examiner: Karl Frech



Serial No.: 10/693,836

Due Date: N/A

Group Art Unit: 2876

MS Petitions

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

We are transmitting herewith the following attached items (as indicated with an "X"):

- ☒ Return postcard.
- ☒ Petition to Withdraw Holding of Abandonment under 37 CFR 1.181 (2 pgs.).
- ☒ A Copy of Response to Final Office Action, a Petition for an Extension of time, and RCE Transmittal, as filed on November 18, 2005 (11 pgs.).
- ☒ A Copy of the PTO stamped returned postcard (1 pg.).
- ☒ A Copy of the Notice of Abandonment mailed on November 30, 2005 (1 pg.).
- ☒ A Copy of Private PAIR Bibliographic Data and Transaction History for U.S. Application No. 10/693836 (2 pgs.).

Please consider this a **PETITION FOR EXTENSION OF TIME** for sufficient number of months to enter these papers and please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.

Customer Number 21186

By: Ann M. McCrackin
Atty: Ann M. McCrackin
Reg. No. 42,858

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 19th day of June, 2006.

Name Amy Moriarty

Signature [Signature]

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.

(GENERAL)

S/N 10/693,836

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Robert N. Goman et al.

Examiner: Karl Frech

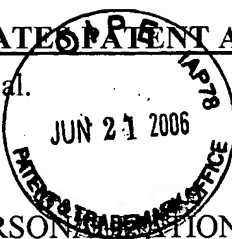
Serial No.: 10/693,836

Group Art Unit: 2876

Filed: October 23, 2003

Docket: 457.010US3

Title: SMART CARD PERSONALIZATION IN A MULTISTATION
ENVIRONMENT



PETITION TO WITHDRAW HOLDING OF ABANDONMENT UNDER 37 CFR 1.181

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

A Notice of Abandonment dated November 30, 2005 (copy enclosed) for the above-identified patent application was received by our office on December 5, 2005. The Notice alleges that Applicants failed to timely file a proper reply to the Final Office Action dated on October 18, 2004. Applicants respectfully disagree.

A response to the Final Office Action along with a Request for Continued Prosecution (RCE) was filed on November 18, 2005, with a Certificate of Mailing reflecting the same. In return, Applicants received a PTO-stamped postcard, dated November 23, 2005, acknowledging receipt of the submitted Response by the USPTO. True and accurate copies of the documents mailed November 18, 2005, along with a copy of the PTO-stamped postcard are enclosed. Also included are the current Bibliographic Data and Transaction History for the above identified matter as it appears in the U.S. Patent Office Private PAIR system. Applicants believe they have timely filed the response and respectfully requests reconsideration of the holding of abandonment.

It is believed that there is no action or omission by Applicants to support a holding that the above-identified application was or is abandoned. Accordingly, it is respectfully requested that the abandonment holding be withdrawn and prosecution resumed as soon as possible.

CONCLUSION

It is Applicants' understanding that no fee is required for a petition to withdraw a holding of abandonment. (See MPEP 711.03(c)), and therefore no fee is enclosed. However, if a fee is required, please charge the required fee to Deposit Account No. 19-0743.

The Examiner is invited to telephone Applicants' attorney at (612-349-9592) to facilitate prosecution of this application.

Respectfully submitted,

ROBERT N. GOMAN ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 349-9592

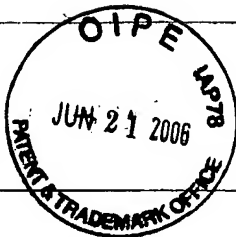
Date June 7, 2006

By Ann M. McCrackin
Ann M McCrackin
Reg. No. 42,858

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 19th day of June, 2006

Name Amy Moriarty

Signature [Signature]



Notice of Abandonment

Application No.

10/693,836

Examiner

Karl D. Frech

Applicant(s)

GOMAN ET AL.

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

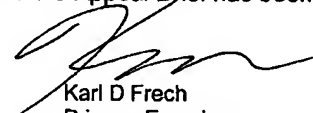
This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 18 October 2004.
 - (a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
 - (b) ☒ A proposed reply was received on 18 April 2005, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.

(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
 - (c) ☐ A reply was received on _____ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
 - (d) ☐ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
 - (a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
 - (b) ☐ The submitted fee of \$_____ is insufficient. A balance of \$_____ is due.

The issue fee required by 37 CFR 1.18 is \$_____. The publication fee, if required by 37 CFR 1.18(d), is \$_____.
 - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
 - (a) ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
 - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☒ The reason(s) below:

The period for filing an Appeal Brief after filing of the Notice of Appeal has Expired. No Appeal Brief has been filed.


Karl D Frech
Primary Examiner
Art Unit: 2876

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

In re Patent Application of: Robert N. Goman et al.

Title: SMART CARD PERSONALIZATION IN A MULTISTATION ENVIRONMENT

Attorney Docket No.: 457.010US3

Serial No.: 10/693,836

RCE

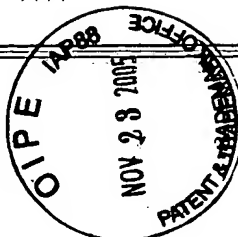
Receipt is hereby acknowledged for the following in the United States Patent and Trademark

Office:

CONTENTS: REQUEST FOR CONTINUED EXAMINATION (RCE) Transmittal (1 pg);
Amendment Under 37 CFR § 1.116 (9 pages); -); Permission to charge Deposit Account No.
19-0743 in the amount of \$395.00 to pay the RCE filing fee; Petition for Extension of Time in the
prior application (1 page); -); Permission to charge Deposit Account No. 19-0743 in the amount of
\$1080.00 to pay the extension fee; and return postcard

Mailed: November 18, 2005
AMM1/ajm

Docket No.: 457.010US3
Due Date: November 18, 2005



BEST AVAILABLE COPY



**REQUEST
FOR
CONTINUED EXAMINATION (RCE)
TRANSMITTAL**

Subsection (b) of 35 U.S.C. § 132, effective on May 29, 2000,
provides for continued examination of an utility or plant application
filed on or after June 8, 1995.
See The American Inventors Protection Act of 1999 (AIPA).

<i>Application Number</i>	10/693,836
<i>Filing Date</i>	October 23, 2003
<i>First Named Inventor</i>	Robert N. Goman
<i>Group Art Unit</i>	2876
<i>Examiner Name</i>	Karl Frech
<i>Attorney Docket Number</i>	457.010US3
<i>Customer No.</i>	21186

This is a Request for Continued Examination (RCE) under 37 CFR § 1.114 of the above-identified application entitled SMART CARD PERSONALIZATION IN A MULTISTATION ENVIRONMENT.

Submission required under 37 C.F.R. § 1.114

1. ☐ Consider the amendment(s)/reply under 37 C.F.R. § 1.116 previously filed on .
2. ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on .
3. ☒ Amendment Under 37 CFR § 1.116 (9 pages) is enclosed.
4. ☐ New power of attorney (pages) is enclosed.
5. ☐ Information Disclosure Statement is enclosed (pages), with:
 - a. Form 1449 (pages)
 - b. Copies of IDS Citations ()
6. ☒ Permission to charge Deposit Account No. 19-0743 in the amount of \$395.00 to pay the RCE filing fee required under C.F.R. § 1.17(e).
7. ☒ The Commissioner is hereby authorized to credit overpayments or charge any fees set forth in 37 CFR §§ 1.16 through 1.18 to Deposit Account No. 19-0743.
8. ☒ Petition for Extension of Time (1 page) is enclosed along with Permission to charge Deposit Account No. 19-0743 in the amount of \$1080.00 to pay the extension fee.

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.

By: Ann M. McCrackin
Atty: Ann M. McCrackin
Reg. No. 42,858

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Attn-Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 18th day of November, 2005.

Ann M. McCrackin

Name

Ann M. McCrackin
Signature

S/N 10/693,836

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Robert N. Goman et al.	Examiner:	Karl Frech
Serial No.:	10/693,836	Group Art Unit:	2876
Filed:	October 23, 2003	Docket No:	457.010US3
Title	SMART CARD PERSONALIZATION IN A MULTISTATION ENVIRONMENT		

PETITION FOR A FIVE-MONTH EXTENSION OF TIME

MS RCE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

In accordance with the provision of 37 CFR § 1.136(a), it is respectfully requested that a five-month extension of time be granted in which to respond to the Notice of Appeal mailed April 18, 2005, said period of response being extended from June 18, 2005 to November 18, 2005.

Please charge Deposit Account No. 19-0743 in the amount of \$1080.00 to cover the required extension fee. Please charge any additional fees or credit overpayment to deposit Account No. 19-0743.

Respectfully Submitted

ROBERT N. GOMAN ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A
P.O. Box 2938
Minneapolis, MN 55402
(612) 349-9592

Date: Nov. 18, 2005 By: Ann M. McCrackin
Ann M. McCrackin
Reg. No: 42,858

CERTIFICATE UNDER 37 CFR § 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 18th day of November 2005.

Name: Ann M. McCrackin

Signature: Ann M. McCrackin



EXPEDITED PROCEDURE – EXAMINING GROUP 2876

S/N 10/693,836

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Robert N. Goman et al.

Examiner: Karl Frech

Serial No.: 10/693,836

Group Art Unit: 2876

Filed: October 23, 2003

Docket No.: 457.010US3

Title: SMART CARD PERSONALIZATION IN A MULTISTATION
ENVIRONMENT

AMENDMENT & RESPONSE UNDER 37 C.F.R. 1.116

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

In response to the Notice of Appeal mailed April 18, 2005, please consider the following response. This response is accompanied by an RCE and a Petition to obtain a five-month extension of the period for filing an Appeal Brief, thereby moving the deadline for response from June 18, 2005 to November 18, 2005.

IN THE CLAIMS

Please amend the claims as follows.

1. (Original) A method of controlling programming of portable programmed data carriers in a system having a plurality of programming stations, the method comprising the steps of:
receiving a card object from a card issuer management system, wherein the card object consists of information for programming the portable programmed data carriers;
receiving a programming request from the programming station; and
utilizing the card object to control the programming station as the programming station programs the portable programmed data carrier.
2. (Original) The method of claim 1, further comprising the step of acquiring data from a data source.
3. (Original) The method of claim 2, wherein the data source is the card issuer management system.
4. (Original) The method of claim 1, further comprising the step of acquiring security services from a security source.
5. (Original) The method of claim 1, further comprising the step of providing support services.
6. (Original) The method of claim 1, wherein the step of receiving a programming request comprises the steps of:
receiving a card object identifier; and
associating the card object identifier with the card object.
7. (Original) The method of claim 2, further comprising the step of acquiring security services from a security source.

8. (Original) The method of claim 7, further comprising the step of providing support services.
9. (Original) The method of claim 8, wherein the step of receiving a programming request comprises the steps of:
 - receiving a card object identifier; and
 - associating the card object with the card object identifier.
10. (Cancelled) A computerized system for controlling programming of portable programmed data carriers across a plurality of personalization stations, the system comprising:
 - a personalization server interface for acquiring services from one of more resources, transferring card information to one of the personalization stations, and controlling the programming of the portable programmed data carrier;
 - a personalization station interface for receiving the card information from the personalization server interface and for programming the portable programmed data carrier.
11. (Cancelled) The computerized system of claim 10, wherein the services acquired by the personalization server interface are data services.
12. (Cancelled) The computerized system of claim 10, wherein the services acquired by the personalization server interface are security services.
13. (Cancelled) The computerized system of claim 10, wherein the services acquired by the personalization server interface are support services.
14. (Cancelled) The computerized system of claim 10, further comprising a controller for receiving a card object identifier and for routing the card object identifier to one of the personalization stations.

15. (Cancelled) A computerized system for controlling programming of portable programmed data carriers across a plurality of personalization stations, the system comprising:
- a means for receiving one or more card objects from a card issuer management system, wherein the card objects comprise information for programming the portable programmed data carriers;
 - a means for receiving a programming request from the programming station; and
 - a means for utilizing the card object to control the programming station as the programming station programs the portable programmed data carrier.
16. (Cancelled) The computerized system of claim 15, further comprising a means for acquiring security services from a security source.
17. (Cancelled) The computerized system of claim 15, further comprising a means for acquiring data from a data source.
18. (Cancelled) The computerized system of claim 17, wherein the data source is the card issuer management system.
19. (Cancelled) The computerized system of claim 15, further comprising a means for providing support services.
20. (Cancelled) The computerized system of claim 15, wherein the programming request comprises a unique card object identifier.
21. (Cancelled) A computer-readable medium having computer-executable instructions for performing the steps comprising:
- receiving one or more card objects from a card issuer management system, wherein the card objects consist of information for programming the portable programmed data carriers;
 - receiving a programming request from the programming station; and

utilizing the card object to control the programming station as the programming station programs the portable programmed data carrier.

22. (Cancelled) The computer-readable medium of claim 21, having further computer-executable instructions for performing the step of acquiring security services from a security source.

23. (Cancelled) The computer-readable medium of claim 21, having further computer-executable instructions for performing the step of acquiring data from a data source.

24. (Cancelled) The computer-readable medium of claim 23, wherein the data source is the card issuer management system.

25. (Cancelled) The computer-readable medium of claim 21, having further computer-executable instructions for performing the step of providing support services.

26. (Cancelled) A computer readable medium having stored thereon a data structure comprising:

- a first data field containing data representing a card object for programming a portable programmed data carrier; and

- a second data field containing data representing a unique card object identifier for identifying the card object represented by the first data field.

27. (Cancelled) A system for issuing portable programmed data carriers comprising:

- a plurality of card objects identified by a like plurality of card object identifiers;

- a plurality of personalization stations for receiving the card object identifiers and for programming the portable programmed data carriers using information contained in the card object identified by the card object identifier;

- a controller for providing to each personalization station the card object identifier; and

a personalization server for controlling the programming of a portable programmed data carrier in response to a request from one of the personalization stations, wherein the personalization server translates the card object into commands and data and transfers the commands and data to the personalization stations making the request.

28. (Cancelled) The system of claim 27, wherein the personalization server acquire services from one or more resources in response to a request from one of the personalization stations.

REMARKS

No claims are amended or added, claims 10 - 28 are canceled,; as a result, claims 1 - 9 are now pending in this application.

Double Patenting Rejection

Claims 10-28 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,196,459.

Applicant respectfully disagrees with the rejection of claims 10 - 28. Nevertheless, Applicant has elected to cancel claims 10 – 28 solely for the purpose of expediting the patent application process. Applicant specifically reserves the right to file a continuation application at a later date to reintroduce these claims.

§102 Rejection of the Claims

Claims 1-9 were rejected under 35 USC § 102(b) as being anticipated by Linden (U.S. 4,827,425).

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). Applicant respectfully submits that the Office Action did not make out a *prima facie* case of anticipation because the reference does not teach each and every claim element.

Independent claim 1 includes the act of “receiving a card object from a card issuer management system” that is not disclosed in Linden. The card issuer management system manages the cardholder data and determines the type of card to issue, the card applications to embed in the card, and what personalization equipment to use to issue the card for a particular cardholder. (Applicant’s Specification, page 7, lines 10-12). Linden does not disclose any selective programming of this sort. Instead, the cards are programmed with data corresponding to the data encoded on the magnetic strips earlier in the assembly line. (Linden, col. 3 line 65 to col. 4 line 12).

Independent claim 1 also includes “receiving a programming request. . .”. There is no programming request in Linden. In contrast, it is assumed that all of the cards are to be programmed as they travel through the in-feed, rotate once around the circular programming table, and then exit through the out-feed. (Linden, col. 3 line 38 to col. 4 line 37).

Thus, Linden does not teach each element of claim 1. In addition, claims 2 - 9 depend, directly or indirectly, on claim 1 and are patentable over Linden for the reasons argued above, and are also patentable in view of the additional elements which they provide to the patentable combination.

Documents Cited but Not Relied upon for this Office Action

Applicant need not respond to the assertion of pertinence stated for the reference cited but not relied upon by the Office Action since this reference is not made part of the rejection in this Office Action. Applicant is expressly not admitting to this assertion and reserves the right to address the assertion should it form part of future rejections.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 349-9592 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

ROBERT N. GOMAN ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 349-9592

Date Nov. 18, 2005

By Ann M. McCrackin
Ann M. McCrackin
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ANN MCCRAKIN

Name

Ann M. McCrackin

Signature



Bibliographic Data

Application Number:	10/693,836	Customer Number:	21186
Filing or 371 (c) Date:	10-23-2003	Status:	Abandoned -- Failure to Respond to an Office Action
Application Type:	Utility	Status Date:	11-28-2005
Examiner Name:	<u>FRECH, KARL D</u>	Location:	ELECTRONIC
Group Art Unit:	2876	Location Date:	-
Confirmation Number:	1017	Earliest Publication No:	US 2004-0256451 A1
Attorney Docket Number:	457.010US3	Earliest Publication Date:	12-23-2004
Class / Subclass:	235/380	Patent Number:	-
First Named Inventor:	Robert Goman , Minneapolis, MN (US)	Issue Date of Patent:	-

Title of Invention:	Smart card personalization in a multistation environment
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Transaction History

Date	Transaction Description
11-30-2005	Mail Abandonment for Failure to Respond to Office Action
11-28-2005	Abandonment for Failure to Respond to Office Action
11-23-2005	Workflow - Request for RCE - Begin
04-18-2005	Notice of Appeal Filed
04-18-2005	Request for Extension of Time - Granted
10-18-2004	Mail Final Rejection (PTOL - 326)
10-15-2004	Final Rejection
10-15-2004	Case Docketed to Examiner in GAU
10-12-2004	IFW TSS Processing by Tech Center Complete
10-12-2004	Case Docketed to Examiner in GAU
09-14-2004	Application Return from OIPE
09-14-2004	Application Return TO OIPE
09-14-2004	Application Dispatched from OIPE
09-14-2004	Application Is Now Complete
08-20-2004	Payment of additional filing fee/Preexam
01-16-2004	Notice Mailed--Application Incomplete--Filing Date Assigned
12-15-2003	Cleared by OIPE CSR
12-11-2003	IFW Scan & PACR Auto Security Review
10-23-2003	Initial Exam Team nn

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